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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92045849
Party	Plaintiff Primepay, Inc.
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

PRIMEPAY, INC.,

PETITIONER,

v.

PRIMEPOINT, L.L.C.,

RESPONDENT.

Cancellation No. 92045849

**PETITIONER PRIMEPAY, INC.’S OPPOSITION TO RESPONDENT’S
MOTION FOR JUDGMENT AGAINST PETITIONER BASED UPON FINAL
RESOLUTION OF CIVIL PROCEEDINGS BETWEEN THE PARTIES**

Petitioner PrimePay, Inc. (“PrimePay”) hereby opposes Respondent Primepoint, L.L.C.’s (“Primepoint”) motion for judgment against PrimePay. Concurrently herewith, PrimePay has filed a motion for leave to amend its petition for cancellation so that the ground for cancellation is PrimePay’s registration to the PRIMEPAY mark, Reg. Nos. 2056092, rather than PrimePay’s common law rights to the PRIMEPAY mark.

With the proposed amended petition for cancellation, the similarity of the marks assessment – that most important confusion factor – changes significantly because the comparison will be between the marks as registered, not between the marks as used in commerce, which is how the District Court compared the marks for purposes of the infringement claim at issue in that proceeding.

As noted in the District Court opinion attached to Primepoint's motion, the Court had previously ruled in a summary judgment opinion that the similarity of marks factor weighed in favor of infringement based upon the similarity of the words and structure of the PRIMEPOINT and PRIMEPAY marks.

In its summary judgment Opinion, the Court noted that the facts as then presented weighed in favor of a finding of likely confusion between the marks. (Op. 23-24.) The Court relied heavily upon the fact that both marks are composed of the same number words (two), the same number of syllables (two), and have the same stress pattern.

Opinion p17. After trial, after having reviewed various brochures and other media on which the parties' marks appear, the Court moderated its previous conclusion and concluded that the similarity of the marks factor *did not favor either party*. The Court's conclusion was based solely on the *appearance* of the marks and various *particular color and stylization differences*:

Having heard all of the evidence at trial and having reviewed the marks in their context – on websites, brochures, signs, banners, mugs, book-covers, letterhead, sales literature, water bottles, pens, baseball caps, mouse-pads, and golf towels - - the Court finds that the marks' similarity weighs neither in favor, nor against, an ultimate finding of a likelihood of confusion. The marks bear substantial similarities, to be sure. The Court is mindful that similar characteristics weigh more heavily than isolated differences. The Court is nonetheless struck by the noticeably different overall "look and feel" of the two marks, despite their similarities. The PrimePay mark appears in a typewriter-like typeface, which conveys the mood and tone of business. The Primepoint mark appears in a more casual and modern sans-serif typeface, accompanied by the swooping graphic element, which conveys a markedly different mood and tone. The similar coloring of the two marks does not mitigate this tonal difference, since the relevant colors - - blue and green – are popular and thus undistinguished. While the Court recognizes that some consumers may be confused by the similar-sounding names, the Court cannot with confidence conclude that such confusion, in the context of their different appearance, is likely or common.

Opinion p17-18 (citations removed).

Where a registrant obtains a standard character mark without claim to any particular font style, size, or color, the registrant is entitled to depictions of the standard

character mark regardless of font style, size, or color. *Citigroup Inc. v. Capital City Bank Group, Inc.*, 637 F.3d 1344, 1353 (Fed. Cir. 2011); *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 950 (Fed. Cir. 2000) (“Registrations with typed drawings are not limited to any particular rendition of the mark and, in particular, are not limited to the mark as it is used in commerce.”) The TTAB’s *duPont* analysis with respect to standard character marks is not restricted by stylizations previously used and is not restricted by any “reasonable manner of use” standard. *Citigroup Inc.*, 637 F.3d at 1352-3 (striking down the “reasonable manner of use” standard as applied to *duPont* analysis of standard character marks).

The mark at issue in PrimePay’s proposed amended petition for cancellation is the PRIMEPAY mark as registered, not the mark as used. *Id.* PrimePay’s registration to PRIMEPAY is in standard characters, which covers *all* manner of stylizations, including the stylization registered later by Primepoint. PrimePay’s particular use of its registered mark is of no material significance since the stylization of such use can be changed at any time according to PrimePay’s fancy. *Vornado, Inc. v. Breuer Electric Mfg. Co.*, 390 F.2d 724, 727 (C.C.P.A. 1968). The rights conferred by the registration reside in the mark as it appears in the registration without regard to other subject matter which PrimePay may elect to use or not use in a particular display.

The Board’s *duPont* analysis comparing the similarity of the mark therefore cannot take into account *any* of the difference relied on by the District Court to change its initial opinion that the similarity factor favored confusion, to its final opinion that the similarity factor favored neither party. In short, the issue of similarity of the marks

before the Board is fundamentally different than the similarity of the marks issue considered by the District Court.

PrimePay's proposed amended petition for cancelation is not claim precluded because a claim for cancelation is not the same as the infringement claim considered by the District Court, and because the marks at issue and the required comparative analysis are fundamentally different as noted above. *See Jet, Inc. v. Sewage Aeration Systems*, 223 F.3d 1360, 1365-66, 55 USPQ2d 1854, 1858-59 (Fed. Cir. 2000) (claim preclusion requires that the second claim is based on the same set of transactional facts).

Similarly, issue preclusion does not prevent the Board from making its own assessment of the similarity of the marks because, as noted above, the marks at issue are fundamentally different and the comparative analysis is different as compared to the marks and analysis before by the District Court.

PrimePay proposes that the other *duPont* factors are either not relevant to the Board's analysis due to presumptions required by the Board, or are issue precluded by the District Court's opinion such that the Board should adopt the Court's findings. In particular, the Board should adopt the Court's finding that the similarity of the goods, channels of trade, and customers all favor a likelihood of confusion. This will considerably narrow the contested issues in this proceeding, requiring the Board only to assess similarity of the marks and balance the factors to make the ultimate likelihood of confusion determination.

As noted in Petitioner's Motion for Leave to Amend, leave to amend is freely given when justice so requires. Fed. R. Civ. P. 15(a). The TTAB follows Rule 15(a) and liberally grants leave to amend petitions and pleadings where the other party will not be

prejudiced thereby. *See Miller Brewing Co. v. Anheuser-Busch Inc.*, 27 USPQ2d 1711 (TTAB 1993) (particularly where challenged pleading is the initial pleading); *Buffett v. Chi-Chi's, Inc.*, 226 USPQ 428 (TTAB 1985); *Cool-Ray, Inc. v. Eye Care, Inc.*, 183 USPQ 618 (TTAB 1974). The TBMP notes, “plaintiffs to proceedings before the Board ordinarily can, and often do, respond to a motion to dismiss by filing, *inter alia*, an amended complaint. If the amended complaint corrects the defects noted by the defendant in its motion to dismiss, and states a claim upon which relief can be granted, the motion to dismiss normally will be moot.” TBMP 503.03. As shown above, the proposed amended pleading corrects the defects noted by Primepoint in its motion and states a claim upon which relief can be granted and which is likely to be granted.

This proceeding is still in its very earliest stages. Primepoint has not yet even filed an answer to PrimePay’s petition for cancellation. Accordingly, there is no basis for Primepoint to assert prejudice or other equitable reasons why leave should be denied.

Dated: September 2, 2011

Respectfully submitted,

YOUNG & THOMPSON

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CERTIFICATE OF SERVICE

The undersigned certifies that the within OPPOSITION TO RESPONDENT'S MOTION was served on the below listed counsel of record for Respondent on this 2nd day of September, 2011 by placement with first class mail, postage prepaid.

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